

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 09/298,910
ATTORNEY DOCKET NO. Q54131

REMARKS

Claims 10, 12, 14 and 16-24 have been examined on their merits, and are all the claims presently pending in the application.

1. Claim 14 stands rejected under 35 U.S.C. § 112 (1st para.) as allegedly failing to comply with the written description requirement. Applicant traverses the § 112 (1st para.) rejection of claim 14 for at least the reasons discussed below.

The specification of the above-identified patent application at page 9, lines 4-8 clearly discloses that the dialing signals can be transmitted to a private branch exchange. Applicant submits that the § 112 (1st para.) rejection of claim 14 has been overcome, and respectfully requests withdrawal of same.

2. Claim 17 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by West, Jr. *et al.* (U.S. Patent No. 4,658,906). Applicant traverses the § 102(b) rejection of claim 17 for at least the following reasons.

Applicant submits that the Patent Office is overlooking the disclosure in West, Jr. *et al.* that the dialed digits are serialized and stored in the transceiver prior to being transmitted to a base station. For example, at col. 7, lines 5-8, West, Jr. *et al.* disclose that each dialed number is provided to a shift register (75) to be sent out over a data line (77) to the transceiver, where it is stored in the transceiver for ultimate transmission when a SEND signal is received. In other words, the dialed digits are stored in the transceiver prior to their transmission. In contrast,

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however, claim 17 recites that a dialed digit signal is transmitted from a subscriber terminal to a telephone exchange *each* time a digit is pressed, which is clearly not the case with West, Jr. *et al.*

Thus, Applicant submits that West, Jr. *et al.* fails to teach or suggest all of the claimed elements as arranged in claim 17. Thus, Applicant submits that claim 17 is allowable, and respectfully requests that the Patent Office reconsider and withdraw the § 102(b) rejection of claim 17.

3. Claims 10, 16 and 18-24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bilgic *et al.* (U.S. Patent No. 5,884,148) in view of Sandler *et al.* (U.S. Patent No. 5,983,117). Applicant traverses the rejection of claims 10, 16 and 18-24 for at least the reasons discussed below.

The Patent Office acknowledges that Bilgic *et al.* fail to teach or suggest the transmission of a dialing signal through the base station to the base station control station each time the dialing signal is generated, as recited in claim 10. The Patent Office alleges that the disclosure of Sandler *et al.* overcomes the acknowledged deficiencies of Bilgic *et al.*

The combination of Bilgic *et al.* and Sandler *et al.* fails to teach or suggest the transmission of a dialing signal through the base station to the base station control station each time the dialing signal is generated, as recited in amended claim 10. The Patent Office has already acknowledged that Bilgic *et al.* fail to teach or suggest such a feature. Therefore, the Patent Office must rely upon Sandler *et al.* for the necessary disclosure. In Sandler *et al.*, if the communications links to BTS and DCP are both established and “SEND” is pressed, *i.e.*, all

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digits are dialed, then the dialed digits are transmitted on a digit-by-digit basis. See, *e.g.*, col. 7, line 8 to col. 8, lines 27; Fig. 2 of Sandler *et al.* In contrast, in the invention recited in claim 10, since the connection signal is transmitted to the base station as the telephone set goes off-hook, if the keys of the dial pad are pressed prior to receipt of the connection acknowledgement signal at the subscriber unit, the dialing signals associated with the keys are temporarily stored and then transmitted when the connection acknowledgement signal is received at the subscriber unit. After the connection acknowledgement signal is received at the subscriber unit, each time the dialing signal is generated, the dialing signal is transmitted to the subscriber unit without storing it. In the combination of Bilgic *et al.* and Sandler *et al.*, all the dialing signals are stored, whereas in the present invention, none or a portion of the dialing signals is stored. Thus, Applicant submits that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

Applicant submits that one of skill in the art would not be motivated to combine the two references. Both Sandler *et al.* and Bilgic *et al.* lack any teaching about the desirability of the transmission of dialing signals each time a digit is pressed. Thus, Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness.

Based on the foregoing reasons, Applicant submits that claim 10 is allowable over the combination of Bilgic *et al.* and Sandler *et al.*, and further submits that claims 18-24 are allowable as well, at least by virtue of their dependency from claim 10. Applicant respectfully requests that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 10 and 18-24.

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With respect to amended independent claim 16, Applicant submits that claim 16 is allowable over the combination of Bilgic *et al.* and Sandler *et al.* for at least reasons analogous to those discussed above with respect to claim 10. Applicant respectfully requests that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 16.

4. Claims 12 and 14 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sandler *et al.* in view of West, Jr. *et al.* Applicant traverse the rejection of claims 12 and 14 for at least the reasons discussed below.

The combination of Sandler *et al.* and West, Jr. *et al.* fails to teach or suggest at least a telephone exchange communicating to a means for producing dialing signals through a base station control station, wherein a dialing signal is transmitted to the exchange each time the dialing signal is generated, as recited in claim 12. The Patent Office acknowledges that Sandler *et al.* fail to teach or suggest a means for producing dialing signals including means for deciding whether a received dialing signal represents a final digit of a dialed telephone number. See pg. 6 of the February 22, 2005 Office Action. The Patent Office alleges, however, that West, Jr. *et al.* provide the necessary disclosure to overcome the acknowledged deficiencies of Sandler *et al.*

As discussed above with respect to claim 17, in West, Jr. *et al.* the dialed digits are serialized and stored in the transceiver prior to being transmitted to a base station. For example, at col. 7, lines 5-8, West, Jr. *et al.* disclose that each dialed number is provided to a shift register (75) and is sent out over a data line (77) to the transceiver, where it is stored in the transceiver for ultimate transmission when a SEND signal is received. Claim 12 recites, however, that a

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dialing signal is transmitted from a means for producing dialing signal to a telephone exchange each time a digit is pressed, which is clearly not the case with West, Jr. *et al.* Moreover, the Patent Office's argument that Sandler *et al.* disclose transmitting the dialing signal to the telephone exchange each time the dialing signal is generated is incorrect. The passages of Sandler *et al.* cited by the Patent Office (col. 3, lines 21-42; col. 8, lines 9-27) only disclose the transfer of dialed digits to the mobile switching center (140). The dialed digits are processed by the digit collection peripheral (160), and once the digit collection peripheral has determined that a valid directory number or service feature request has been entered, the digit collection peripheral sends the dialed number to the mobile switching center via the signaling interface (158). *See* col. 9, lines 44-47 of Sandler *et al.* In light of this disclosure of Sandler *et al.*, the combination of Sandler *et al.* and West, Jr. *et al.* does not teach or suggest the transmission of dialing signals to a telephone exchange each time a digit is pressed.

To the extent that the Patent Office is arguing that the mobile switching center (140) is equivalent to a telephone exchange, one of skill in the art is aware of the differences between a mobile switching center and a telephone exchange. Sandler *et al.* disclose that a mobile switching center handles the routing of calls to voice/data facilities, *e.g.*, trunk or line facilities, which one of skill in the art recognizes as a telephone exchange. Sandler *et al.* also disclose the routing of the calls to the PSTN once the dialing is complete. *See* col. 9, lines 50-55 of Sandler *et al.* Furthermore, both Sandler *et al.* and West, Jr. *et al.*, either alone or in combination, lack any teaching or suggestion of any devices that could be reasonably construed as a telephone exchange. Thus, Applicant submits that the Patent Office cannot fulfill the "all limitations"

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prong of a *prima facie* case of obviousness, as required by *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

Applicant submits that one of skill in the art would not be motivated to combine the two references. Both Sandler *et al.* and West, Jr. *et al.* lack any teaching about the desirability of the transmission of dialing signals to a telephone exchange each time a digit is pressed. Thus, Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness.

Based on the foregoing reasons, Applicant submits that the combination of Sandler *et al.* and West, Jr. *et al.* fails to teach or suggest all of the claimed elements as arranged in claim 12. Thus, Applicant submits that claim 12 is allowable, and respectfully requests that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 12.

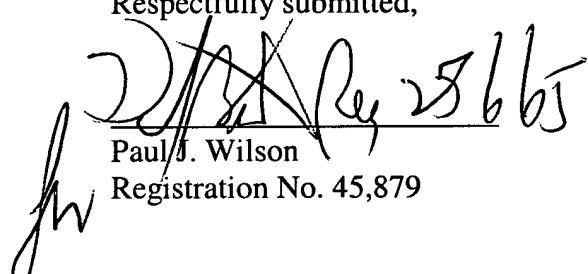
With respect to independent claim 14, Applicant submits that claim 14 is allowable for at least reasons analogous to those discussed above with respect to claim 12, in that the combination of Sandler *et al.* and West, Jr. *et al.* fail to teach or suggest at least the transmission of dialing signals to a private branch telephone exchange each time a digit is pressed. Applicant submits that claim 14 is allowable, and respectfully requests that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 14.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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WASHINGTON OFFICE
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